



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/560,834

02/28/2007

Johann Manner

4838-001

6903

22429

7590

02/18/2009

LOWE HAUPTMAN HAM & BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

02/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/560,834	MANNER ET AL.	
	Examiner	Art Unit	
	Cheryl Juska	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/05, 01/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to for the lack of headings identifying the required sections as provided in 37 CFR 1.77(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 1-4, 8, and 9 are indefinite for claiming the invention in terms of physical properties rather than the chemical or structural features that produce said properties. *Ex parte Slob*, 157 USPQ 172, states, "Claims merely setting forth physical characteristics desired in an article, and not setting forth specific composition which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart said desired characteristics." Also, "it is necessary that the product be described with sufficient particularity that it can be identified so that one can determine what will and will not infringe." *Benger Labs, Ltd v. R.K. Laros Co.*, 135 USPQ 11, *In re Bridgeford* 149 USPQ 55, *Locklin et al. v. Switzer Bros., Inc.*, 131 USPQ 294. Furthermore, "Reciting the physical and chemical characteristics of the claimed product will not suffice where it is not certain that a

Art Unit: 1794

sufficient number of characteristics have been recited that the claim reads only on the particular compound which applicant has invented.” *Ex parte Siddiqui*, 156 USPQ 426, *Ex parte Davission et al.*, 133 USPQ 400, *Ex parte Fox*, 128 USPQ 157.

Note applicant’s claims merely describe a lyocell fiber having a desired ratio V of fiber strength to fiber elongation. The claims do not positively recite any physical or chemical features that will produce the claimed ratio. Thus, applicant’s claims are indefinite because they encompass lyocell fibers either presently existing or in the future which might impart the desired ratio.

5. Claim 6 is indefinite for limiting the fiber titer to 6.5 dtex or more. Claim 6 depends from claim 5 which limits said titer to 6-25 dtex. Since claim 6 does not have an upper limit to the titer range, it is broader in scope than claim 5. As such, the claim is rendered indefinite because it is unclear if applicant intends the range to have an upper limit. Claim 7 is similarly rejected.

6. Claim 7 is indefinite for reciting a broad range together with a narrow range that falls within the broad range. When this occurs within the same claim, said claim is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). In the present instance, claim 7 recites the broad recitation “12 dtex or more,” and the claim also recites “preferably 15 dtex or more” which is the narrower statement of the range.

7. Claim 9 provides for the use of the lyocell fiber, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is

Art Unit: 1794

intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-4, 8, and 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for lyocell fibers comprising a titer of about 6-25 dtex and having the claimed ratio V, does not reasonably provide enablement for lyocell fibers having the claimed ratio V. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Note the specification teaches the fiber titer is critical to obtaining the claimed ratio V (specification, page 2, 6th and 8th paragraphs). Thus, applicant's claims are non-enabled because they encompass lyocell fibers either existing or in the future which have the desired ratio V by means of a chemical or structural feature other than titer size. In other words, applicant's claims encompass lyocell embodiments that applicant has not invented. Applicant's invention is limited to obtaining the claimed ratio V by means of a particular fiber titer range. Therefore, claims 1-4, 8, and 9 are rejected as non-enabled according to 112, 1st paragraph.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 1794

11. Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102/103

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,235,392 issued to Luo et al.

Luo discloses lyocell fibers and a method of making said fibers (title and abstract).

While the invention of the patent is directed to microdenier lyocell fibers (abstract and claims), the reference explicitly teaches fibers made by centrifugal spinning having diameters in the range

Art Unit: 1794

of 3.1-19.5 denier (3.4-21.7 dtex) are easily formed (col. 11, lines 13-22). Additionally, Luo teaches the fiber lengths vary from 0.5-25 cm (i.e., staple fiber length) (col. 11, lines 22-24).

Thus, Luo teaches applicant's claims 1-8 with the exception of the recited ratio V. However, it is reasonable to presume that said ratio is inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. lyocell fibers having a denier of about 3-20). Like materials cannot have mutually exclusive properties. The burden is upon applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed ratio V would obviously have been provided by the process disclosed by Luo. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 1-8 are rejected.

Conclusion

15. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1794

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Juska/
Primary Examiner
Art Unit 1794

cj
February 18, 2009